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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,430	03/23/2004	Shih Kwan Liu	3129/73	2942

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EXAMINER

LEE, KYUNG S

ART UNIT PAPER NUMBER

2832

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,430

Applicant(s)

LIU ET AL.

Examiner

Richard K. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2-8 are objected to because of the following informalities: In claim 2, "separated by varistor layer" 2 lacks grammatical clarity. In claim 3, "said pair of first and second inner electrodes formed on one and the same plane of said varistor layer are in multiples" lacks clarity since applicant discloses different pairs formed on different layers, or in multiples, but the same "said pair in one and the same plane" cannot be formed in multiples. The claim implies there may be multiples on the same plane. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the first and second electrodes of said pair are formed on different planes and also on the same plane,

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as required by claim 1. This renders unclear whether "said first and second electrodes of said pair" in claim 2 refers to the same elements of "one pair of first and second inner electrodes" since the pair cannot be on the same and different planes at the same time.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b,e)¹ as being anticipated by Greier et al. Greier discloses the claimed invention at figs. 3, 9 or 12, with first and second outer electrodes 2, 3 and the first and second inner electrodes 19, or 4,5. The ends of the electrodes 4, 5 at fig. 12 are the top

¹ The 35 USC 102(b) category applies for the published PCT document listed on the front of Grier et al. which is its equivalent or otherwise the same document.

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diagonal portions at the second end of first inner electrode 4 and the bottom diagonal of the second end of the second inner electrode 5, which are in a non-facing relation, facing to the right and upwards and to the left and downwards, and laterally displaced, as from the left to the right. Each end is electrically connected to the outer electrodes. Or at fig. 9, the first inner electrode 4 has a first end towards and facing the bottom of the figure, while the second inner electrode 5 has an end on towards and facing the top of the figure, so that they are laterally offset from top to bottom, and also alternatively, offset laterally from left to right, and are non-facing, and electrically connected to outer electrode 2 and 3. In claims 2-4, some of the inner electrodes are formed on the same plane with others on different planes, where claim 2 is interpreted to mean that some of the set of inner electrode pairs are on different planes. In claims 5-8, the length has to be one of the other of smaller, greater or equal, as those are the only choices. Or as alternative, the length is smaller than the width of the varistor if one takes the width of the varistor as the same direction as the length of the electrode.

Response to Arguments

6. Applicant's arguments filed 1/14/05 have been fully considered but they are not persuasive. Applicant argues that the Greier inner electrode second opposing ends that are in the same plane are not in a non-facing relation, and are not laterally displaced from one another. The examiner respectfully disagrees. As noted above, the Greier inner electrodes second ends are both facing up and down as to fig. 9, or up and to the right, and down and to the left as to fig. 12, with a lateral offset from left to right or top to bottom as noted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard K. Lee whose telephone number is (571) 272-1994. The examiner can normally be reached on Mon-Tue & Thu-Fri 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard K. Lee
Primary Examiner
Art Unit 2832

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11/10/05